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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,840	03/12/1999	SCOTT EVANS	EVA-001	7636

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EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/267,840

Applicant(s)

EVANS, SCOTT

Examiner

F. J. BARTUSKA

Art Unit

3627

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 21-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation of providing means for said debtor to access said transaction community without system enrollment on an account specific basis by said creditor or by said debtor cannot be found in the original specification, claims or drawings. Page 34, lines 8-10 of the applicant's specification discloses that the transaction community asks the debtor to provide a secure pass code to bring up account information. Page 54, lines 11-13 of the applicant's specification discloses: "After login, said debtor is presented with the account information screen 240 (see Fig. 29)". Clearly, account information has already been entered in the transaction community. Nowhere does the specification disclose that someone other than the

debtor or the creditor entered the account information effectively enrolling the debtor in the system. Further, page 33, lines 9-12 of the applicant's specification disclose that a new debtor is invited to join the transaction community using a new customer service option. Page 36, lines 5-16 of the applicant's specification disclose that the user must enter a customer ID and receive proper authentication. Page 38, lines 10 and 11 of the applicant's specification discloses that an account number verification will be requested from the customer. Pages 54, 58 and 70 of the applicant's specification disclose that the debtor must login to the system using a User ID and a password to access his or her account. It is clear from these examples that an account has been set up for the user and therefore the user is enrolled in the system. The claims are rejected below as if they were claiming that the biller enrolls the debtor.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

Claims 21, 23, 24, 29, 30, 31, 32, 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al, both of record. Lamm discloses sending a bill over the Internet, see col. 5, line 21 and col. 11, lines 60-62, a bill identification number is disclosed in col. 10, lines 54-57 and col. 13, lines 22-26, the bill identification number is an authorization code which is included in the payment instructions back to the biller, see col. 15, lines 46-49. Col. 7, lines disclose that the billing party may deal directly with the bill payers. Including advertising material with the bill is disclosed in col. 14, lines 61-66. Payment by credit card authorization is disclosed in col.

Art Unit: 3627

16, lines 44-47. Lamm does not disclose enrollment of new accounts by the biller. Remington et al disclose an electronic bill presentment and payment system in which the biller enters all account information for new accounts, see col. 5, lines 44-55, col. 7, lines 50-60 and col. 10, lines 3-15. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Remington et al to have the biller in Lamm control the information that establishes new accounts.

Claims 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al as applied to claim 21 above in further view of Bednar et al. Lamm, as modified by Remington et al, shows all the features of the applicant's claimed invention except payment by electronic check. Bednar et al show a system for paying bills with the electronic check shown in Fig. 5. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Bednar et al to modify the device of Lamm to allow payment by electronic check to give the bill payers more ways to pay the bills.

Claims 25, 26, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al as applied to claim 21 above in further view of Hilt et al. Lamm, as modified by Remington et al, shows all the features of the applicant's claimed invention except payment of the bills through the mail. Hilt et al disclose paying bills in col. 13, lines 48-50 paying bills either electronically or through the mail. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Hilt et al to modify the device of Lamm to allow payment through the mail to give the bill payers more ways to pay the bills.

Claims 27, 28, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al as applied to claim 21 above in further view of Ziarno. Lamm, as modified by Remington et al, shows all the features of the applicant's claimed invention except the means to allow the bill payor to make political or charitable contributions. Ziarno discloses a method for making political or charitable contributions, see col. 5, line 55, over the Internet, see col. 11, line 26, using electronic funds transfer, see col. 10, line 2. It would

have been obvious to one of ordinary skill in the art in view of the showing and teaching of Ziarno to provide the device of Lamm with means to allow the bill payor to make political or charitable contributions over the Internet as a further service to the bill payor.

### ***Response to Arguments***

The applicant's remarks have been considered but have not been found persuasive because the original specification does not disclose that it was not the debtor or the creditor that set up the account; thereby, effectively enrolling the debtor.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened



Art Unit: 3627

statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fjb

F. J. BARTUSKA  
PRIMARY EXAMINER